



UNITED STATES PATENT AND TRADEMARK OFFICE

84

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,716	06/27/2003	Roger D. Tung	VPI96-11DIV2	7621
1473	7590	08/09/2006	EXAMINER	
FISH & NEAVE IP GROUP ROPES & GRAY LLP 1251 AVENUE OF THE AMERICAS FL C3 NEW YORK, NY 10020-1105			TUCKER, ZACHARY C	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/607,716

Applicant(s)

TUNG ET AL.

Examiner

Zachary C. Tucker

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-43 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>27Jun03</u> . | 6) <input type="checkbox"/> Other: ____. |

Requirement for Restriction
~and~
Election of Species

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-32 and 43, drawn to chemical compounds of the formula (II), classified in class 548, wherein the compound comprises a pyrrolidine ring, or in class 562, wherein the compound comprises a carboxylic acid group, for example. Compounds according to formula (II) will fall into numerous U.S. patent classes, depending on the identities of the variables in formula (II).
- II. Claims 33-42, drawn to methods of treating or preventing hepatitis C virus infection and divers other diseases or conditions, comprising administering to a patient a compound as set forth in Group I hereinabove, and a pharmaceutical composition comprising a compound as set forth in Group I hereinabove, all classified in class 514 in subclasses depending on the identities of the variables in formula (II).

The inventions are independent or distinct, each from the other because:

Inventions I and II are related as product and process of using the product. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the methods as set forth in Group II are practicable with materially different products, such as a

combination of ribavarin and interferon $\alpha 2b$, for treatment of hepatitis C infection. The compounds as set forth in Group I are not limited in their utility to only active ingredients in pharmaceutical compositions as are set forth in Group II; the examples disclosed in the instant specification, pages 103-108, demonstrate utility as *in vitro* enzyme inhibitors, as opposed to the *in vivo* methods to which claims in Group II are drawn.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, as evidenced by the differing patent classifications, restriction for examination purposes as indicated is proper.

This Requirement is Further Set Forth as Follows:

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species (*one* compound from Group I, should Group I be elected, or *one* compound of which the pharmaceutical composition is comprised and which is to be administered to the patient, should Group II be elected) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. The identity of the species of the invention that is elected will guide the examiner's search of the prior art. For example, should the elected species be a compound according to formula (II) wherein "W" is a phosphonyl moiety, compounds of formula (II) wherein "W" is a sulfonyl-containing moiety will not necessarily be searched.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, **and a listing of all claims readable thereon**, including any claims subsequently added. An argument that

a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election. Applicant is furthermore requested to kindly indicate exactly what the identities of each of the structural variables in formula (II) are (*i.e.* "T," "K," "M," "A²," "A¹," "L" and "W") in the compound elected as the species to be examined.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a). Examination subsequent to election of species requirement is described in MPEP § 803.02.

This Requirement is Subject to the Following Condition:

The examiner has required restriction between compounds, pharmaceutical compositions, and method of use claims. Where applicant elects claims directed to compounds, and a compound claim is subsequently found allowable, withdrawn pharmaceutical composition claims and method of use claims that depend from or otherwise include all the limitations of the allowable compound claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Pharmaceutical composition claims and method of use claims that depend from or otherwise include all the limitations of the patentable compound** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the compound claims and the rejoined pharmaceutical composition claims and method of use claims will be withdrawn, and the rejoined pharmaceutical composition and method of use claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected compound claim is found allowable, an otherwise proper restriction requirement between compound claims, pharmaceutical composition claims and method of use claims may be maintained. Withdrawn pharmaceutical composition claims and method of use claims that are not

Art Unit: 1624

commensurate in scope with an allowed compound claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the pharmaceutical composition claims and method of use claims should be amended during prosecution either to maintain dependency on the compound claims or to otherwise include the limitations of the compound claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is advised that the reply to this requirement to be complete must include an election of an invention (and a species of the invention) to be examined even though the requirement be traversed (37 CFR 1.143).

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Conclusion

Any inquiry concerning this communication should be directed to Zachary Tucker whose telephone number is (571) 272-0677. The examiner can normally be reached

Art Unit: 1624

Monday to Friday from 5:45am to 2:15pm. If Attempts to reach the examiner are unsuccessful, contact the examiner's supervisor, James O. Wilson, at (571) 272-0661.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

zt

A handwritten signature in black ink, appearing to be "Z. O. Wilson", followed by a long horizontal line extending to the right.